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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/019,706
Filing Date: May 01, 2002
Appellant(s): KASTNER, STEFAN

Scott K. Witonsky
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/9/08 appealing from the Office action
mailed 1/29/08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2,800,709	GAUL	07-1957
CN 1105615 A	HU	07-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaul (2,800,709) in view of Hu (CN 1,105,615).

Gaul discloses producing an aluminum composite material (figs. 1-5), wherein at least one cladding layer (2) from a first aluminum material (col. 3, lines 47-51) is provided, the cladding layer (2) is placed on a side of an ingot (1) made from a second aluminum material (col. 3, lines 47-51), and the cladding layer (2) and the ingot (1) are rolled wherein the rolling comprises several roll passes thereby producing the aluminum composite material (col. 4, lines 68-75). Gaul discloses treating at least one surface of the second ingot by preheating and then scalping (col. 4, lines 32-47). *See also figures 1-5 for further clarification.*

Gaul, however, does not disclose sawing the cladding layer from a first ingot made from a first aluminum in a longitudinal direction, the sawing comprising band sawing.

Hu discloses sawing a metal ingot (4) in a longitudinal direction using a band saw (3), in order to provide a machine that is low in cost, reduces the amount of material consumed during sawing of the ingot, free from contamination, and has a wide variety of application ranges and increased working efficiency. *See abstract and figure for further clarification.*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to saw the layer of Gaul from an ingot in a first longitudinal direction using a band saw, in light of the teachings of Hu, in order to

provide a layer that was longitudinally band sawed from an ingot and free from contamination by using a machine that is low in cost, small in material consumption, and has a wide variety of ranges and increased working efficiency.

Regarding **claims 8, 11, and 16**, Gaul/Hu discloses all of the claimed subject matter except for the cladding layer having a thickness of 2mm to 100mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cladding layer of Gaul/Hu with a thickness in the range of 2mm to 100mm, as the Examiner takes Official Notice that cladding layers in such a thickness range are conventional and are of sufficient thickness to provide the intended desirable cladding characteristics. Further, it has been held where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves on routine skill in the art. *In re Aller*, 105 USPQ 233.

(10) Response to Argument

Appellant states that Gaul and Hu, fail to teach or suggest “sawing at least one cladding layer of a specified thickness suitable for use as a cladding layer from a first ingot made from a first aluminum material in a longitudinal direction...” Appellant states that Gaul or Hu fail to teach or suggest “sawing said aluminum cladding sheet from said first ingot in a longitudinal direction at a specified thickness suitable for use as a cladding sheet...”

In response, the Examiner maintains that Hu discloses sawing at least a layer from a first ingot made from steel in a first longitudinal direction as clearly shown in the figure wherein this layer has the size to be capable of being used as a cladding layer.

The ingot material of Hu is not aluminum, however, the primary reference to Gaul does in fact disclose a cladding layer being made from aluminum, and although Gaul is silent with respect to the manner by which the aluminum cladding layer is formed, the teachings of Hu disclose that a layer can be cut from an ingot using a saw moving in a first longitudinal direction wherein the layer produced by Hu appears to have dimensions capable of use as a cladding layer. In addition, since Hu longitudinally cuts the steel ingot using a saw as only an example, the example shown in Hu does not prevent one of ordinary skill in the art from realizing that a less dense material such as an aluminum ingot can be longitudinally cut using the saw of Hu.

Appellant states that Gaul does not disclose that the sheet, plate or liner can be formed from an aluminum ingot.

In response, the Examiner maintains that Gaul is silent with respect to the manner by which the aluminum cladding layer is produced, the Examiner provided the secondary reference to Hu which teaches a layer of material similar in dimension to the aluminum cladding layer of Gaul being produced by sawing a first ingot in a longitudinal first direction. The teachings of Hu clearly disclose in the figure the sawing of an ingot in a first longitudinal direction to produce a layer. The teachings of Hu are clearly capable of producing a dimensionally size appropriate layer from an ingot by sawing which appears to be capable of being used as a cladding layer.

Appellant states that there is no suggestion or motivation to combine the teachings of Gaul and Hu.

In response to appellant's statement that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gaul being the primary reference discloses all of the claimed subject matter as explained in detail above, however, Gaul fails to disclose the manner by which the cladding layer is produced. Hu discloses that a layer can be cut from an ingot in a first longitudinal direction using a saw efficiently and accurately such as to reduce material consumption and provide a layer that is free from contamination wherein the layer appears to have similar dimensions as the cladding layer of Gaul. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to saw the layer of Gaul from an ingot in a first longitudinal direction using a band saw, in light of the teachings of Hu, in order to provide a layer that was accurately sawed from an ingot and free from contamination by using a machine that is low in cost, reduces the amount of material consumption, and has a wide variety of ranges thereby providing increased working efficiency.

Appellant states that only viewing Gaul and Hu with impermissible hindsight that the Office Action reaches the conclusion that one having ordinary skill in the art at the

time the invention was made would saw an ingot in a longitudinal direction using a band saw to form a cladding layer.

In response to appellant's statement that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge (i.e. using a saw to cut an ingot in a first longitudinal direction to produce a layer of capable of being used in a manufacturing process) which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The step of cutting a layer from an ingot in a longitudinal direction using a saw is not a novel concept as evidenced by Hu. The base reference to Gaul teaches all of the steps except for the cladding layer being produced from an ingot that is sawed in a first longitudinal direction. Therefore, the combination of Gaul with the secondary teachings of Hu would provide one of ordinary skill in the art at the time of invention with the necessary teaching and motivation as to how to produce a layer of material similar in dimension to the cladding layer of Gaul from an ingot, and that teaching alone provides the necessary motivation and not appellant's disclosure for the cited combination above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Conferees:

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